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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,205	10/27/2000	Reinhold Mayr	MAYRRRETAL-1	3274

7590

03/20/2003

Collard & Roe
1077 Northern Boulevard
Roslyn, NY 11576

EXAMINER

PETERSON, KENNETH E

ART UNIT PAPER NUMBER

3724

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/674,205

Applicant(s)

MAYR ET AL.

Examiner

Kenneth E Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) 7, 9 and 10 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the German patent to Wallers (DE003406455A1) in view of Sakurai et al. '845.

Waller's shows a cantilevered saw blade having all of the recited limitations including a saw frame (4), a slider crank drive (6), a feeder conveyor (11), a cantilevered blade (2), an conveyor motor (15), a controlling system (21) having a "stored control program" (39) and a signal transmitter (16).

Waller's elements are all mechanical. However, it has long been held to be obvious to update old mechanical machinery with modern electronics, usually because the electronics are cheaper and need not be specially manufactured for the given situation, but instead need only be programmed. Sakurai shows that it is well known to have a sensor (41) to monitor blade speed, to send an electronic signal to a computer controller, and to use that information to control how the work is fed (33) relative to the tool. Given Sakurai's general teaching that sawing machine workfeed should be controlled by such a system, it would have been obvious to one of ordinary skill in the art to have modified Wallers by replacing his outdated mechanical control system with a more modern electronic system. The advantages of an electronic system are set forth in Sakurai and many other sawing systems. A further example of the advantages are

the ability to input the material of the workpiece and therewith select from a variety of programs for cutting different materials at different speeds.

3. Claim 8 is allowed.

4. Applicant's arguments have been fully considered but they are not persuasive.
Applicant has overcome the Wallers rejection under 102b.

In regards to the 103 rejection, Applicant argues that Wallers is a reciprocating saw that has an intermittent workfeed, whereas the secondary reference to Sakurai is a band saw that has a continuous workfeed, and therefor it is not obvious to combine the two references. However, Examiner is not literally combining the references, but instead Examiner is judging what the two references, together, would suggest to one of ordinary skill in the art, especially in light of numerous court cases that have ruled it to be obvious to update old machines with modern electronics. The valve controller (21) of Wallers is expensive to manufacture because it is specific to this particular application and therefor must be engineered from scratch. What modern engineers have been doing in the last few decades is replace such expensive mechanical items with electronic equipment that is *programmable* to perform the same function, since programming is significantly cheaper than engineering a part from scratch. Sakurai is an example of such a technological progression. In the olden days, the regulated feeding of a workpiece relative to a band saw was done with hydraulic systems, but then the engineers naturally moved to a complete electronic system as seen in Sakurai.

In the current case, an engineer building Waller's machine today would naturally replace the hydraulic system with an electronic system. The valve would be replaced with a sensor (like Sakurai's sensor 41) and controller (similar to Sakurai's controller), the hydraulic fluid would be replaced with electrons (just like Sakurai), the hydraulic motor would be replaced by a motor that was electronically controllable (just like Sakurai). All the engineer need then do is *program* Waller's new electronic system to do the same thing that Waller's old mechanical system used to do, just like Sakurai programmed his electronic bandsaw to do just what the bandsaws from the olden days did.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday thru Thursday between 7am and 4pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

kp
March 20, 2003


KENNETH E. PETERSON
PRIMARY EXAMINER